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Supreme Court of the United States

October Term, 1947

No. 652

HAROLD E. EDGERTON,

Petitioner,

vs.

LAWRENCE C. KINGSLAND, Commissioner
of Patents,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR
THE DISTRICT OF COLUMBIA AND BRIEF IN
SUPPORT THEREOF.**

✓
DAVID RINES,
Attorney for Petitioner.

✓
FRANK W. DAHN,
Of Counsel.

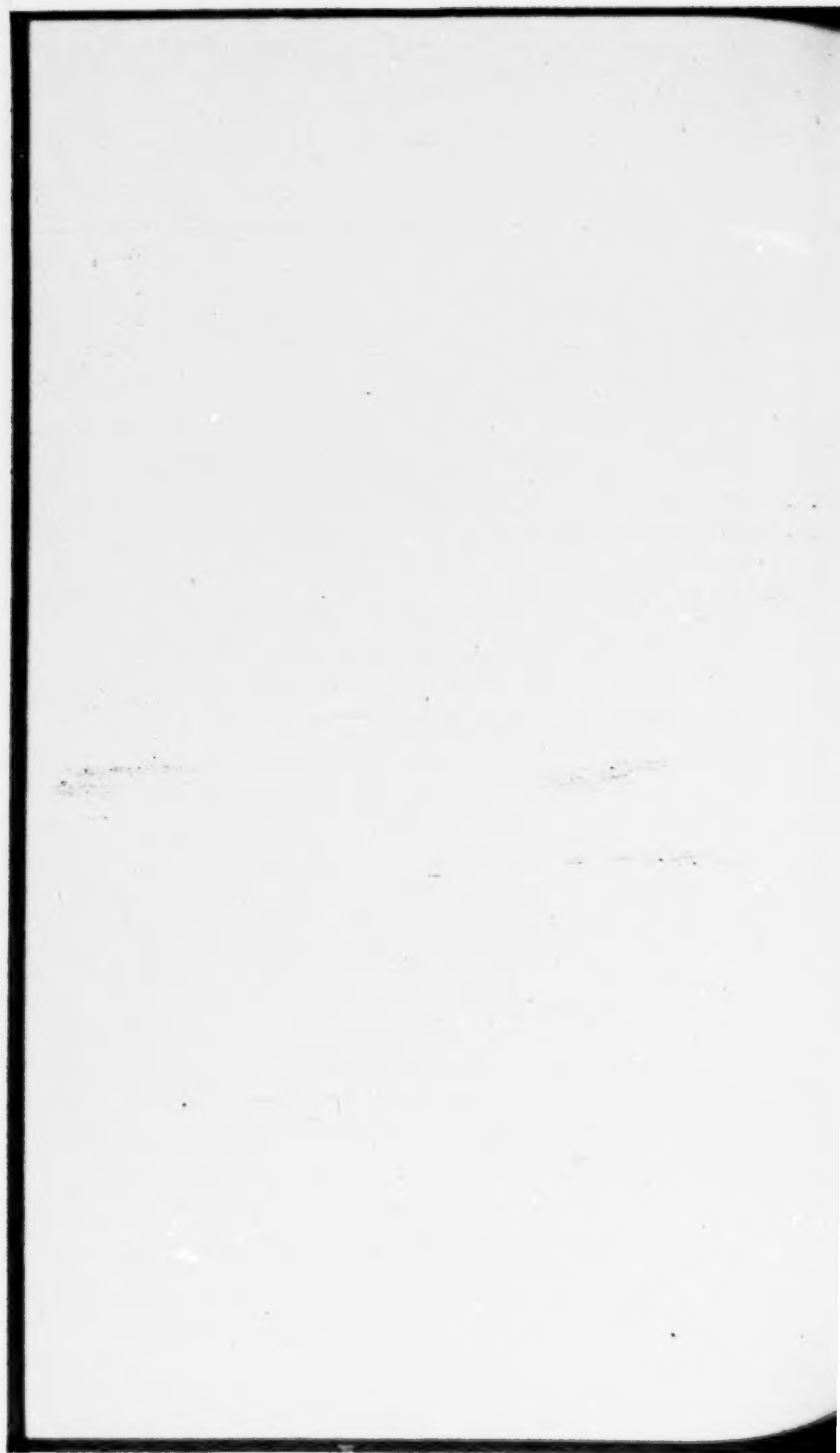


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No.

HAROLD E. EDGERTON,

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vs.

LAWRENCE C. KINGSLAND, Commissioner
of Patents,

Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

*To the Honorable the Chief Justice and the Associate
Justices of the Supreme Court of the United States:*

Your petitioner, Harold E. Edgerton, by his attorneys, respectfully prays that a writ of certiorari be issued to the United States Court of Appeals for the District of Columbia to review a judgment of that Court entered in the above cause December 4, 1947 (R. p. 579), affirming the dismissal of your petitioner's complaint by the District Court, request for rehearing having been denied January 6, 1948 (R. p. 588).

On the said December 4, 1947, the said Court of Appeals rendered three separate judgments, one in each of three

consolidated suits between the same parties. The judgment in No. 9361 only is involved on this petition. Not all the issues involved in that suit, No. 9361, moreover, are pertinent on this proceeding. On the contrary, this petition deals with the one issue only as to the proper construction to be placed upon the recent holdings of this Honorable Court in *Hoover Company v. Coe*, 325 U. S. 79.

The Question Presented

The question presented by this petition involves the construction of a United States statute, Section 4915, R.S. (U.S.C. Title 35, Sec. 63), and it is of great public importance. This statute and also another statute, Section 4911, R.S. (U.S.C. Title 35, Sec. 59a), are quoted on pp. 13 to 15, *infra*. Section 4915 provides for the filing of a complaint in the District Court whenever a patent is refused by the Board of Appeals of the Patent Office.

Prior to the decision of this Court in the *Hoover* case, Section 4915 was uniformly construed to mean that such complaint could not be filed in the District Court until after a final decision by the Patent Office upon the whole merits of the patent application.

The question presented, therefore, is whether, from now on, contrary to the practice heretofore prevailing, it will be necessary for a patent applicant to resort to the District Court piecemeal upon each and every separate occasion that the Patent Office may render a separate decision involving one or more separate claims of the patent application.

The Reasons Relied Upon for the Allowance of the Writ of Certiorari

The answer to this question will affect the rights of every applicant for patent whose application has been unjustly refused by the Patent Office piecemeal.

In the present instance, the Patent Office, as will be stated more fully in detail hereinafter, had in 1941 rendered a piecemeal decision adjudicating some only of the claims involved in your petitioner's patent application, Serial No. 685,501, filed August 16, 1933 (R. p. 207), but it had not at that time passed upon any of the remaining claims of the application. In the words of the Court of Appeals for the District of Columbia (R. p. 581),

“At the time of the rejection of the static inverter claims other claims in the appellant's application had not yet been disposed of.”

The Patent Office did ultimately render a complete decision upon the whole merits of your petitioner's application, but not until several years later, in 1945.

Under the practice in force prior to the Hoover decision, your petitioner was unable to avail himself of the provisions of the said Section 4915 of the Revised Statutes until after the complete decision upon the whole merits, in 1945. He did not, therefore, file any complaint in the District Court following upon the Patent Office piecemeal decision of 1941.

The Court of Appeals for the District of Columbia holds, however, that this Court's decision in the Hoover case has now changed the law (R. p. 582):

“The appellant contends that if recourse to the courts had been taken within six months after the decision of the Board of Appeals in 1941 it would have

been premature since the Board's rejection of claims 74 and 76 to 81 inclusive at that time did not then dispose of the entire application. But this contention is answered adversely to the appellant by *Hoover Company v. Coe*, 325 U. S. 79 (1945)."

If the understanding of the Court of Appeals as to the holdings of this Honorable Court in the Hoover case is correct, then those holdings have, indeed, been revolutionary, for they have overturned a practice that has been in force since at least the time of King James, according to which a party may not appeal piecemeal.

It is accordingly very important to obtain promptly a ruling as to whether the Court of Appeals correctly understands the holdings of this Honorable Court in the Hoover case.

As the Commissioner of Patents has his official residence in the District of Columbia, and as all *ex parte* complaints under Section 4915 are necessarily, therefore, filed in the District Court for the District of Columbia, there appears to be no possibility of obtaining a different ruling from any other Court of Appeals as to the construction to be placed upon this Court's holdings in the Hoover case.

If the decision of the Court of Appeals should be allowed to stand, it will be productive of much mischief. It will add greatly to the already heavy burdens carried by those who, relying upon Article 1, Section 8, of the United States Constitution, relating to the promotion of the progress of science and useful arts, apply to the Patent Office, in good faith, for patents to cover inventions that they have made, at great expense and after considerable effort, in order to benefit the public. The record shows that your petitioner's invention is among those that have greatly benefited the public.

It has heretofore been the policy of the law to encourage, not to hinder, such benefactors. It will not, however, encourage an applicant for patent to know that, before he can obtain his patent, he will be compelled to file as many separate complaints in the District Court as there may be separate piecemeal decisions by the Patent Office relating to separate claims of his application, each complaint involving a separate trial in the District Court on substantially the same identical record, together with many repetitions of the presentation of that identical record in the Court of Appeals.

If the decision of the Court of Appeals should be allowed to stand, the prosecution of an application in the Patent Office will revert to the condition described as far back as 1905 in connection with a related matter by the Court of Appeals itself, *Allen v. U. S. ex rel. Lowry*, 26 App. D. C. 8, 18:

"if successive appeals be permitted, the result would be only to add another terror to the many surrounding an interference proceeding in the Patent Office. From the simple and summary mode first adopted for determining the question of priority of invention, that proceeding, by system of Patent Office rules, has grown to be a veritable old man of the sea, and the unfortunate inventor who becomes involved therein is a second Sinbad the Sailor * * *. Should we affirm the decision of the court below, * * * we should be placing still another burden of successive piece-meal appeals upon the unfortunate interferant in a proceeding which, when decided, is not final. * * *"

Summary of the Matter Involved

Your petitioner is associate professor of electrical engineering at the Massachusetts Institute of Technology, Cambridge, Massachusetts. He is a pioneer in the art of speed photography.

On August 16, 1933, he filed in the United States Patent Office his before-mentioned application, Serial No. 685,501.

His invention, however, was made as far back as 1928 or 1929 and it aroused great interest from the very first. To satisfy this interest, your petitioner demonstrated his invention very widely, and he published numerous papers in the technical periodicals (R. pp. 123, 124).

This stimulated the filing by others of applications covering his invention, with the result that your petitioner became involved in numerous interferences, which have held up the issue of his patent, even up to the present day.

As a result of these numerous interferences, your petitioner's application contains a very large number of claims.

Among these are claims 74 and 76 to 81 (R. pp. 3 to 5) referred to in the above quotations from the decision of the Court of Appeals. These claims 74 and 76 to 81 each specifies a flash-producing system comprising a new combination of old elements, one of which is a "static inverter". It will not be necessary, for present purposes, to explain the meaning of the term "static inverter". The term is introduced here merely because the Court of Appeals finds it convenient to refer to these claims 74 and 76 to 81 as static-inverter claims (R. p. 580).

These static inverter claims 74 and 76 to 81 originated in patent 2,043,484 (R. p. 367), issued June 9, 1936, on application filed June 15, 1934, to a predecessor of Cities Service Oil Co., as assignee of one Benjamin Miller. Though these static-inverter claims 74 and 76 to 81 cover your petitioner's invention, though your petitioner had disclosed this invention to the Patent Office, in his said application, Serial No. 685,501, as far back as August 16, 1933, long prior to Miller's filing date, June 15, 1934, the

Patent Office had inadvertently permitted the Miller patent 2,043,484 to issue without first declaring an interference to determine who was the first inventor.

Your petitioner, therefore, promptly copied these static-inverter claims 74 and 76 to 81 from the Miller patent 2,043,484, and requested that his application be put into interference with this patent, for the purpose of determining priority of invention. Pursuant to this request, Interference 74,402 was declared on June 11, 1937 (R. p. 581).

After the declaration of the interference, the interfering parties filed sealed preliminary statements alleging their respective dates of invention. When these preliminary statements were opened by the Patent Office, it was found that the dates of invention alleged by Miller as to these static-inverter claims 74 and 76 to 81 were subsequent even to your petitioner's filing date, August 16, 1933 (R. pp. 12, 23). There appeared to be no reason, therefore, insofar as these static-inverter claims 74 and 76 to 81 were concerned, for continuing the interference controversy further to the stage of taking testimony to prove who was the prior inventor.

The Patent Office, therefore, issued an order requiring Miller to show cause why judgment should not be summarily rendered against him as to these static-inverter claims 74 and 76 to 81 (R. pp. 12, 23). This was the same procedure that is described in *News Projection Corporation v. Western Union Tel. Co.*, 38 F. Supp. 854, 855.

To avoid such judgment, Miller, under the provisions of Rule 122 of the Rules of Practice of the Patent Office, filed a motion to dissolve the interference (R. p. 23).

The grounds alleged in the motion to dissolve were so entirely unfounded (as was demonstrated later by testi-

mony in the District Court, R. pp. 182 to 201) that no one abreast of the art could possibly have been misled thereby. But the Patent Office is by no means abreast of the art. In *Westinghouse Electric & Manufacturing Co. v. Radio Corporation*, 24 F. Supp. 933, 939, 943, for example, the Patent Office was severely criticized for misinterpretations and misunderstandings arising out of its lack of familiarity with the art.

Owing to similar misinterpretations and misunderstandings in the said Interference 74,402, the Primary Examiner of the Patent Office, on November 23, 1938 (R. p. 525), granted Miller's motion to dissolve as to the static-inverter claims 74 and 76 to 81, erroneously holding that your petitioner's application, Serial No. 685,501, does not disclose a static inverter.

Your petitioner appealed to the Board of Appeals, but that tribunal, on July 18 and April 4, 1939, affirmed the Primary Examiner's decision dissolving the interference (R. p. 23).

Interference 74,402 was thereupon summarily dissolved without affording your petitioner an opportunity to take *inter-partes* testimony to demonstrate that his application does actually disclose a static inverter. He was not permitted to present any testimony until he appeared in the District Court.

From the Patent Office decision dissolving the interference, your petitioner was without remedy to seek a review in the courts, since it was not a final decision upon the whole merits, *Allen v. U. S. ex rel. Lowry, supra*, *American Cable Co. v. John A. Roebling's Sons Co.*, 62 App. D. C. 103, 65 F. 2d 801, 802, *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. 2d 847, 848, *Gyro Process Co. v. Coe*,

70 App. D. C. 390, 107 F. 2d 195, 199.. The only course open to your petitioner, therefore, was to resume the *ex parte* prosecution of the application, in order to obtain an adjudication of the remaining claims of his application. The further *ex parte* proceedings are described in the decision of the Court of Appeals, as follows (R. p. 581):

"On March 26, 1940, the Primary Examiner rejected the claims upon the same grounds as those upon which he had dissolved the interference. On December 23, 1940, he repeated this ruling and made it final. On August 1, 1941, the Board of Appeals affirmed this rejection. Thereafter within the time allowed by the rules of the Patent Office, the appellant filed a petition for rehearing. On September 16, 1941, this was denied by the Board of Appeals. No appeal under Rev. Stat. § 4911 (1875), 35 U. S. C. § 59a (1940), was taken to the Court of Customs and Patent Appeals. The complaint under Rev. Stat. § 4915 was not filed in the District Court within six months after September 16, 1941."

The complaint was not filed until June 1, 1945. This was within six months of the 1945 Patent Office decision, upon the whole merits.

The Patent Office, the District Court and the Court of Appeals have ruled that, because your petitioner did not avail himself of the provisions of either Section 4911 or Section 4915 of the Revised Statutes at the time of the Patent Office piecemeal decision of 1941, your petitioner's right to the static-inverter claims 74 and 76 to 81 has become final and *res judicata*, irrespective of your petitioner's incontrovertible showing, by evidence, in the District Court, that his original application did, in fact, disclose a static inverter, and that the Patent Office holding to the contrary, upon the basis of which Interference 74,402 was dissolved, had been erroneous.

The complaint (R. p. 1) in the District Court involved not only the static-inverter claims 74 and 76 to 81, but also a further claim 222 (R. pp. 583 to 585) which had not yet been adjudicated by the Patent Office at the time of the piecemeal decision of 1941.

Jurisdiction

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 1, 1925. The judgment of the Court of Appeals, as already stated, was entered on December 4, 1947, and the petition for rehearing was denied on January 6, 1948. This judgment was entered on appeal from a judgment by the District Court for the District of Columbia dismissing a complaint brought under the provisions of Section 4915 U. S., to have remedy from the refusal of the Board of Appeals of the Patent Office to grant a patent to your petitioner (R. p. 30). Some of the previous decisions of this Court bearing on jurisdiction are:

Butterworth v. Hill, 114 U. S. 128.

Gandy v. Marble, 22 U. S. 432.

Morgan v. Daniels 153 U. S. 120.

Steinmetz v. Allen 192 U. S. 543.

American Steel Foundries v. Robertson, 262 U. S. 209.

Hoover Company v. Coe, *supra*.

WHEREFORE, your petitioner, feeling himself aggrieved by the judgment of the Court of Appeals for the District of Columbia, respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the said United States Court

of Appeals for the District of Columbia, commanding that Court to certify and send to this Court for its review and determination, on a day certain to be herein named, a full and complete transcript of the record and all the proceedings in the case numbered and entitled on its docket No. 9361, Harold E. Edgerton, Appellant, v. Lawrence C. Kingsland, Commissioner of Patents, Appellee, and that said judgment of the said Court of Appeals for the District of Columbia may be reversed by this Honorable Court, and that your petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just.

DAVID RINES,
Attorney for Petitioner.

FRANK W. DAHN,
Of Counsel.

We hereby certify that we have read the foregoing petition for a Writ of Certiorari, and that in our opinion it is well founded and presents grounds whereon the prayer ought to be granted, and we further certify that it is not intended for purposes of delay.

DAVID RINES,
Attorney for Petitioner.

FRANK W. DAHN,
Of Counsel.

Supreme Court of the United States

October Term, 1947

No. _____

HAROLD E. EDGERTON,

Petitioner,

vs.

LAWRENCE C. KINGSLAND, Commissioner
of Patents,

Respondent.

BRIEF IN SUPPORT OF THE PETITION FOR A WRIT OF CERTIORARI

I. The Opinion of the Court below

The opinion of the Court of Appeals for the District of Columbia was rendered December 4, 1947 (R. p. 579). A petition for rehearing was denied January 6, 1948 (R. p. 588).

The District Court's Informal Memorandum and its Findings of Fact and Conclusions of Law appear on pages 27 to 29 of the record.

II. Statement of the Case

The facts are set forth in the "Summary of the Matter Involved" in the petition for the writ of certiorari.

III. Specification of Errors

The Court of Appeals for the District of Columbia erred:

1. In affirming the dismissal of your petitioner's complaint in the District Court, and upon a misconstruction of this Honorable Court's holdings in *Hoover Company v. Coe*, 325 U. S. 79.

2. In affirming the dismissal of your petitioner's complaint in the District Court upon the ground that your petitioner's right to the static-inverter claims 74 and 76 to 81 had become *res judicata*.

3. In holding, contrary to the practice uniformly in force prior to the decision in the *Hoover* case, that the proper time for your petitioner to have invoked Section 4911 or 4915 of the Revised Statutes was within six months of the Patent Office piecemeal decision of 1941, prior to any adjudication of your petitioner's application by the Patent Office upon the whole merits.

4. In refusing to decide the case upon its merits, and deciding it instead upon the ground of *res judicata*.

IV. Statutes Involved

Sec. 4911, R. S. (U. S. C., title 35, sec. 59a). If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under Section 4915 of the Revised Statutes (U. S. C., title 35, sec. 63). If any party to an interference is dissatisfied with the decision of the board of interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference

shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

Sec. 4915, R. S. (U. S. C. Title 35, sec. 63). Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the Court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there

are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross examination of the witnesses as the Court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

NOTE: The above statutes are quoted as amended by Act of August 5, 1939, after the declaration of Interference 74,402, Edgerton v. Miller.

V. Summary of Argument

- A. The Courts will not entertain piecemeal appeals.
- B. The rule that piecemeal appeals will not be entertained has been enforced from the earliest times up to the present day.
- C. What is a final judgment?
- D. Examples of final judgments.
- E. It is no more permissible to appeal piecemeal from an administrative body than from a District Court.
- F. The same principle as to piecemeal appeals applies to the Patent Office.
- G. Hoover Company v. Coe, 325 U. S. 79, has not changed the law that an applicant for patent may not appeal piecemeal.

VI. Argument

A. The Courts Will Not Entertain Piecemeal Appeals.

The general rule was stated by Mr. Justice Brandeis in Collins v. Miller, 252 U. S. 364, 370:

"A case may not be brought here by appeal or writ of error in fragments. To be appealable, the judgment must be not only final, but complete [citing cases]. And the rule requires that the judgment to be appealable should be final not only as to all the parties, but as to the whole subject-matter and as to all the causes of action involved . . . Here a single judgment deals with the detention on three affidavits. Only one branch of the case has been finally disposed of below, therefore none of it is ripe for review by this court."

The same Justice held later, in *Nyanza Steamship Company v. Jahneke Drydock*, 264 U. S. 439:

"The decree leaves the cause of action *in personam* for damage undisposed of . . . the judgment must be not only in its nature final, but a complete disposition of the cause."

See also *Catlin v. United States*, 324 U. S. 229, 233, 234, and *Gospel Army v. City of Los Angeles*, 331 U. S. 543.

An appellate court may not waive this requirement of finality, even where both parties to the suit consent that it do so. In *Florian v. United States*, 114 F. 2d 990, 993, for example, where the Circuit Court of Appeals for the Seventh Circuit assumed jurisdiction to decide an appeal under "unusual" circumstances, because

"we are not disposed, in view of the stipulation and attitude of the parties, to invoke any technical reasoning against it",

the Supreme Court, *United States v. Florian*, 312 U. S. 656,

"reversed for want of jurisdiction in the Circuit Court of Appeals because of the absence of a final judgment in the District Court."

The Appellate Court will even go back of the pleadings to find out whether there has, in fact, been a final decision upon the whole merits, as in *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. 2d 847, 848, where the bill was so framed that it

"contains on its face sufficient allegations to confer jurisdiction upon the District Court. The exhibits, however, disclose that the Examiner of Interferences and the Board of Appeals did not decide the issue as to priority of invention in the interference proceedings and did not refuse a patent."

The Court, therefore, declined to take jurisdiction, looking behind the allegations of the bill to the true facts, to determine whether there had, in actual truth, been a final decision upon the whole merits of the controversy.

B. The Rule That Piecemeal Appeals Will Not Be Entertained Has Been Enforced From the Earliest Times up to the Present Day.

a. The Practice Prior to the Enactment of the Federal Rules of Civil Procedure.

In *Cobbledick v. United States*, 309 U. S. 323, 325, this Court explained that

"Congress from the very beginning has, by forbidding piecemeal disposition on appeal of what for practical purposes is a single controversy, set itself against enfeebling judicial administration."

This rule has been consistently adhered to from the earliest times, *Beebe v. Russell*, 19 How. 283, 284:

"It has been the object of this court at all times . . . to restrict the cases which have been brought to this court . . . to those in which the rights of the parties have been fully and finally determined by judgments or decrees in the court below."

Though the appellate jurisdiction in the federal-system procedure is purely statutory, nevertheless, as stated in *McLish v. Roff*, 141 U. S. 661, 665, this

"was only declaratory of a well settled and ancient rule of English practice. At common law no writ of error could be brought except on a final judgment."

As stated in *Libbey-Owens-Ford Glass Co. v. Sylvania Industrial Corporation*, 154 F. 2d 814, 815,

"This carries out a federal policy going back to the early days of the Republic It is reiterated as a policy of desirable and affirmative substance 'against piecemeal litigation' in *Catlin v. United States*, 324 U. S. 229, 233, 234."

b. The Original Federal Rules of Civil Procedure Have Not Changed this Practice.

The Federal Rules of Civil Procedure were construed in *Reeves v. Beardall*, 316 U. S. 283, 286. There, a disposal of part of a case, relating to a promissory note, was held to be final, under the provisions of Rule 54 (b), because the remaining part of the case arose out of an entirely different matter, a contract not to change a will.

In the present case, however, the claims of your petitioner's application all relate to the same single invention. The same invention is covered by the static-inverter claims 74 and 76 to 81, and also by claim 222, which was likewise discussed in the decision of the Court of Appeals. Attention is invited to the decision of the Court of Appeals in the Hoover case, 79 App. D. C. 172, 175, 144 F. 2d 514, 517:

"Theoretically each patent claim is a distinct invention. Therefore, the refusal of any single claim appears in the pleadings under Section 4915, R. S. as the refusal of a patent on a distinct invention. Actually, however, in applications containing multiple claims the claims often do not represent distinct inventions but only different ways of describing a single invention."

As recently stated by the Court of Customs and Patent Appeals, in application of *Wood*, 155 F. 2d 547, 551,

"an applicant for a patent has the right to express in a single application and in more than one claim *the*

same invention, although worded in different language or including elements omitted in other claims" (italics supplied).

The Court went on to say that an applicant, "in a single application", may have

"article and method claims, Markush claims, species claims and broad and narrow claims",

all expressing "the same invention". Indeed,

"patent lawyers usually present and are by the Patent Office permitted to present several claims covering *the same invention*, though worded in different language" (italics supplied).

In *Libbey-Owens-Ford Glass Co. v. Sylvania Industrial Corporation*, *supra*, the Court held that the Rules of Federal Procedure, as construed in *Reeves v. Beardall*, *supra*, lend

"no countenance to the idea that different defenses to the *same* claim may be reviewed in piecemeal fashion" (italics the court's),

and concluded, page 817, that, in view of these Federal Rules,

"The law now carries out the historic federal policy . . . the policy is the fruit of experience."

There was a dissenting opinion that went off on another angle, but even the dissenting opinion agreed with the principle that prohibits (p. 824)

"the piecemeal disposition of what for practical purposes is a single controversy."

In *Leonard v. Socony-Vacuum Oil Co.*, 130 F. 2d 535, 536, the court explained that it was not the intent of the Rules of Federal Procedure

"to make such partial summary judgment final and appealable. In fact, had such been the intent, it would have brought about the very end desired to be avoided,—delay and waste of time in appealing piecemeal, even though the party still has a cause of action pending, where he may have a final judgment disposing of all controversies between the parties."

c. The Amended Federal Rules of Civil Procedure Have Likewise Not Changed This Practice.

As stated in *Western Contracting Corporation v. National Surety Corporation*, 163 F. 2d 456, 459, indeed, the practice even of *Reeves v. Beardall*, *supra*, is no longer in force, since

“the Amended Rules recently adopted by the Supreme Court * * * reestablish the old practice even as to claims which are separate and distinct, except * * *”

See also *Petrol Corporation v. Petroleum Heat and Power Co.*, 162 F. 2d 327, 329 and *Cannister Co. v. National Can Corporation*, 163 F. 2d 683, 685.

C. What is a Final Judgment?

It is therefore in order to determine what is a “final judgment”.

The term “final judgment” is defined in *Beebe v. Russell*, *supra*, at p. 285:

“When a decree finally decides and disposes of the *whole merits* of the cause, and reserves no further questions or direction for the future judgment of the court, so that it will not be necessary to bring the cause again before the court for its final decision, it is a final decree” (*italics supplied*).

See also *St. Louis, Iron Mountain & Southern Railroad Co. v. Southern Express Co.*, 108 U. S. 24, 28:

“a decree is final, for the purposes of an appeal to this court, when it terminates the litigation between the parties on the merits of the case, and leaves nothing to be done but to enforce by execution what has been determined.”

Nothing less is final, as explained in *Heike v. United States*, 217 U. S. 423, 430:

"Many interlocutory rulings and orders effectually dispose of some matters in controversy, but that is not the test of finality for purposes of appeal or writ of error. The purpose of the statute is to give a review in one proceeding after final judgment of matters in controversy in any given case. Any contrary construction of the Court of Appeals Act may involve the necessity of examining successive appeals or writs of error in the same case, instead of awaiting, as has been the practice since the beginning of the Government, for one review after final judgment, disposing of all controversies in that case between the parties."

D. Examples of Final Judgments.

a. Examples Prior to the Federal Rules of Civil Procedure.

An example of what is a final judgment is accorded by *Globe-Wernicke Co. v. Fred Macey Co.*, 119 F. 696, 703. In a suit for patent infringement and unfair competition, a demurrer as to the unfair competition was sustained, and the case proceeded to a trial of the infringement. It was held that the plaintiff could not appeal from the dismissal of the suit as to the unfair competition until after a decision as to the infringement:

"The bill was not founded upon two separate matters or transactions. The conduct of the appellee complained of consisted of the same acts. . . . the case proceeds until all the matters are decided, whereupon a final decree is entered."

The decision would have been different, of course, if the acts giving rise to the suit for patent infringement had not been the same as those giving rise to the suit for unfair competition, because two entirely different causes of action would then have been involved, *Zalkind v. Scheinman*, 139 F. 2d 895, 900, cert. denied, 322 U. S. 738.

Where two patents are in suit upon allied causes of action, and the bill is dismissed as to one, similarly, there can be no appeal until the final decree as to both, *Kelsey Wheel Co. v. Universal Rim Co.*, 296 F. 616, 623.

A similar question arose in *ex parte* National Enameling and Stamping Co., Petitioner, 201 U. S. 156, 160, and it was similarly held that a suit upon twelve claims of a single patent did not break up the one suit into twelve suits.

b. Examples Subsequent to the Federal Rules of Civil Procedure.

In *Leonard v. Socony-Vacuum Oil Co.*, *supra*, it appeared that suit had been brought under the Sherman Anti-Trust Act, alleging five items of damage. As to two of those five items, the defendants obtained summary judgment, and the plaintiff appealed. The appeal was dismissed, p. 536:

"It is obvious that plaintiffs here relied upon only one cause of action—damage to his business resulting from defendants' alleged violation of the Anti-Trust Act. The different elements of damage were not claimed to have resulted from different transactions but to have arisen from the one alleged cause of action based upon one conspiracy."

Biggins v. Oltmer Iron Works, 154 F. 2d 214, similarly, involved a suit to recover \$13,308.80 for five items of services rendered by the plaintiff as a sales representative for the period commencing in November, 1942, and extending to March 1, 1944. A summary judgment was entered as to two items only, totalling \$8,874.05. Before the trial upon the remaining three items amounting to \$4,434.75, the defendant appealed from the summary judgment as to the said two items. The Court of Appeals for the Seventh Circuit held that the summary judgment as to the two items was not appealable, because not final. The cause of action,

though based upon five items, constituted only a single claim for services rendered over a period of more than a year. The case was entirely unlike *Reeves v. Beardall*, *supra*, where the matters in controversy had been "entirely distinct."

It is not necessary, for present purposes, to explain why the appeal was actually permitted.

In *Libbey-Owens-Ford Glass Co. v. Sylvania Industrial Corporation*, *supra*, the Court of Appeals for the Second Circuit remarked, p. 814:

"An order merely striking one of several defenses and allowing the action to continue for adjudication of the rest would seem as nearly interlocutory as any pleading ruling can ever be."

The same would appear to apply to a piecemeal decision disposing of some claims only of a patent application, but permitting the prosecution of the remaining claims to continue.

While riding in a truck owned by a gas company, the plaintiff was injured through collision with a railroad train. Suit having been entered against the railroad alone, the defendant filed a third-party complaint, seeking to implead the gas-company owner and the driver of the truck. The lower Court sustained a motion to dismiss the railroad's third-party complaint for lack of jurisdiction. The Court of Appeals for the Fourth Circuit, Baltimore and Ohio Railroad Co. v. United Fuel Gas Co., 154 F. 2d 545, dismissed an appeal from this ruling upon the ground that the District Court's ruling was not a final judgment.

E. It is no More Permissible to Appeal Piecemeal From an Administrative Body Than From a District Court.

The principle that a case is not appealable piecemeal is not confined to appeals from District Courts. It has been

uniformly held that preliminary and interlocutory orders of an administrative body, the same as those of the District Court, are not appealable. The administrative remedies must be exhausted before there may be any review of the administrative action, *United States v. Los Angeles & Salt Lake Railroad Company*, 173 U. S. 299, *Myers v. Bethlehem Shipbuilding Corp.*, 133 U. S. 41, 51, *Federal Power Commission v. Metropolitan Edison Co.*, 304 U. S. 375, 385, *Macauley v. Waterman Steamship Corp.*, 327 U. S. 540, 545, *Federal Power Commission v. Arkansas Power & Light Co.*, 330 U. S. 802. As stated in *Rochester Telephone Corp. v. United States*, 307 U. S. 125, 131, this is

"Partly . . . an aspect of the procedural philosophy pertaining to the federal courts whereby, ever since the Judiciary Act, Congress has been loath to authorize review of interim steps in a proceeding."

F. The Same Principle as to Piecemeal Appeals Applies to the Patent Office.

The same principle naturally applies to the Patent Office, since the Patent Office is an administrative body. It is the administrative body designated by Congress to issue patents, Section 481, R.S. (U.S.C. Title 35, Section 6).

It is now in order, therefore, to show that the same rule that has been applied in connection with other administrative bodies has been applied also in connection with the jurisdiction of the District Court, under Section 4915 of the Revised Statutes, and of the Court of Customs and Patent Appeals, under Section 4911 of the Revised Statutes.

Sections 4911 and 4915 of the Revised Statutes have been construed by the Court of Appeals of the District of Colum-

bia upon a number of occasions. In *Carlin v. Goldberg*, 45 App. D. C. 540, 544, for example, that Court remarked:

"The right of appeal from the decisions of the Commissioner of Patents to this court and the procedure by which such appeals may be perfected are purely statutory, and must be strictly followed. Short-cut methods in the Patent Office for the purpose of avoiding prolonged litigation and facilitating a final appeal contrary to express statutory procedure are not within the discretionary power of the Commissioner, and, if indulged, would lead to injustice and endless confusion."

Earlier still, more than a third of a century ago, in *Cosper v. Gold*, 34 App. D. C. 194, 197, the same Court held:

"We have had occasion heretofore to call attention to the fact that the jurisdiction of this court to entertain appeals from the Commissioner of Patents is limited to two classes of decisions, namely, a *final* rejection of an application for a patent, and a *final* award of priority to one of the parties in an interference case" (italics supplied).

The rule in *inter partes* cases is well illustrated in *Allen v. U. S. ex rel. Lowry*, 26 App. D. C. 8, 18, a quotation from which appears on page 5 of the accompanying petition for the writ of certiorari. This was followed by the Court of Appeals for the Third Circuit in *Synthetic Plastics Co. v. Ellis-Foster Co.*, *supra*.

In *ex parte* cases, similarly, the District Court has not heretofore entertained jurisdiction until there has been a *final* decision in the Patent Office upon the *whole merits* of the case.

- a. The Jurisdiction of the District Court under Section 4915 of the Revised Statutes.

As the Court of Appeals correctly understands (R. p. 582), Section 4915 reads:

“Whenever a *patent* on application is refused by the Board of Appeals * * * the applicant * * * may have remedy by bill in equity * * *”.

It does not read,

“Whenever a *claim* of a patent on application is refused * * *”

Section 4915 of the Revised Statutes does not provide that a District Court, under its provisions, may adjudge that the applicant is entitled

“to receive a patent for his invention, as specified in *any claim*”.

It reads rather:

“as specified in *his claim*”.

The language “his claim”, in the statute, has repeatedly been construed to mean *all the claims*, not merely “any claim”, Seymour v. Osborne, 11 Wall 516, 546; Merrill v. Yeomans, 94 U. S. 568.

According to the provisions of Section 4915 of the Revised Statutes, therefore, an applicant may file a complaint asking the District Court to authorize the Commissioner of Patents to grant him a patent for *his invention*, as specified in *all the claims* of his application. He may not sue, under the provisions of Section 4915, in response to separate rejections, one claim at a time.

The Patent Office itself has heretofore construed the statute in this way. In *ex parte* King, 366 O. G. 3, reproduced in the Appendix, p. 31 *infra*, it appeared that the Board of Appeals, although disposing finally of most of the claims on appeal before it, raised new grounds of rejection as against one only of the appealed claims. It became necessary, therefore, to remand the application to the primary examiner for consideration as to the new grounds of rejection.

If the decision of the Court of Appeals in the present case is sound, therefore, the applicant, in that case, should have appealed promptly to the Court without waiting for a final decision upon the whole merits. Acting Commissioner Kinnan, however, ruled distinctly that, in a case of that kind,

“* * * the decision of the Board can and should be regarded as not a final decision in the case.

If, after the Examiner has considered the new grounds of rejection and any amendment seeking to avoid them, the case again is before the Board, on further appeal, a final decision on all the appealed claims can be rendered.”

Acting Commissioner Kinnan continued:

“This practice appears necessary, since otherwise the applicant would be forced either to abandon his right to go back to the Examiner or to take the case to the court without an issue having been reached as to part of the appealed claims.”

Under the reasoning of Acting Commissioner Kinnan, the Patent Office 1941 piecemeal rejection of the static-inverter claims 74 and 76 to 81 only was not a final decision on the whole merits.

b. The Jurisdiction of the Court of Customs and Patent Appeals under Section 4911 of the Revised Statutes.

The Court of Customs and Patent Appeals has the same jurisdiction over appeals from the Patent Office that the Court of Appeals of the District of Columbia used to have, and under the same statute, *Headley & Thompson v. Bridges*, 48 F. 2d 938, 941, *Sinko Tool & Manufacturing Co. v. Automatic Devices Corporation*, 136 F. 2d 186, 190, and the remedies obtainable under the provisions of Sections 4911 and 4915 of the Revised Statutes are coextensive, *Pitman v. Coe*, 62 App. D. C. 365, 68 F. 2d 412, 414.

The Court of Customs and Patent Appeals, under the provisions of Section 4911 of the Revised Statutes, therefore, refuses to entertain jurisdiction of an appeal from the Patent Office, except after a decision upon the whole merits.

In re Rundell, 55 F. 2d 450, 454, a case arising in the Court of Customs and Patent Appeals, for example, even the dissenting opinion recognized that

"If the order * * * is an interlocutory order, the rule is well established that we have no jurisdiction to entertain an appeal from it. This rule is so well established that it needs no citation of authority to support it."

G. Hoover Company v. Coe, 325 U. S. 79, Has Not Changed the Law That an Applicant For Patent May Not Appeal Piecemeal.

It is now in order to study the Hoover decisions, both in the Court of Appeals and this Court.

In that case, the Court of Appeals had considered the question whether one could proceed under the provisions of Section 4915 of the Revised Statutes in a situation where there had actually been a *final* decision by the Patent Office upon *all* the claims in controversy, but where, nevertheless, there still remained something further to be done before the plaintiff could get his patent; namely, in that case, to declare an interference. In the language of the Court,

"Turning now to the cases we find an explicit ruling by the Supreme Court that a proceeding under Section 4915, R. S. cannot select a single issue which affects plaintiff's right to a patent, without determining all the other issues on which that right depends * * *."

In a footnote, the Court referred to *Butterworth v. Hoe*, 112 U. S. 50, in which

“it was indicated that the record in a suit under Section 4915, R. S. should include the *whole merits* of the applicant’s right to a patent” (*Italics supplied*).

The Court of Appeals of the District of Columbia considered that, since there still remained the possibility of declaring an interference in that case, it could not take jurisdiction, page 516:

“Since the court can not decide the whole controversy on its merits we have no jurisdiction over the intermediate proceedings in the Patent Office.”

This Court, *Hoover Company v. Coe*, 325 U. S. 79, 82, re-stated this principle in the following words:

The court below held that in conformity to the general rule, a court of equity ought not to afford piecemeal relief pending completion of the administrative process, and consequently ought not to entertain a suit under the statute unless its adjudication would conclude all possible questions to the right to a patent.”

This Court appeared fully to approve the principle, however, as to piecemeal appeals. The reversal was based rather upon the ground that the principle had been misapplied by the Court of Appeals, p. 90:

“The ruling of the Board of Appeals in the instant case was neither a procedural ruling nor an interlocutory one as to which the District Court should not entertain a suit under R. S. 4915. On the contrary, it finally denied a patent on the claims presented. In this respect it was like a dismissal of a suit in a court.”

In the present case, the 1941 piecemeal decision of the Board of Appeals of the Patent Office did *not* involve *all* the claims in controversy. It was a piecemeal decision involving the static-inverter claims 74 and 76 to 81 only. Had the law in 1941 permitted an appeal at that time as to the

static-inverter claims 74 and 76 to 81, it would have become necessary to enter a further appeal as to claim 222 in 1945.

The piecemeal decision of 1941, therefore, was actually an interlocutory decision only. It was not even comparable to "a dismissal of a suit in a court". It was comparable rather to a dismissal of part only of a suit. A litigant may not appeal after dismissal of part only of the matters involved in a suit. He must wait until the whole merits have been disposed of.

VII. Conclusion

According to the practice in force in 1941, it was not permissible at that time to invoke either Section 4911 or 4915 of the Revised Statutes, since the piecemeal decision relating to the static-inverter claims 74 and 76 to 81 was *not* a final decision upon the whole merits, *ex parte* King, page 27, *supra*, and Cosper V. Gold, page 25 *supra*. It is believed that this Honorable Court's decision in the Hoover case has not overruled these cases.

It is respectfully submitted, therefore, that this Court should take jurisdiction of this case, grant the writ of certiorari, reverse the judgment of the Court of Appeals for the District of Columbia, and direct that a new judgment be entered by the District Court authorizing the Commissioner of Patents to issue a patent to your petitioner including the static-inverter claims 74 and 76 to 81.

Respectfully submitted,

DAVID RINES,
Attorney for Petitioner.

Frank W. Dahn,
Of Counsel.

APPENDIX

Ex Parte King

Official Gazette of the United States Patent Office,

Volume 366, January 1928, Page 3.

Decided December 15, 1927.

1. APPEALS—ADDITIONAL REFERENCES CITED BY BOARD—
RULE 139—PRACTICE.

Where the Board of Appeals, in affirming the rejection of the Examiner, cited additional references against some of the claims, Held that, under the provisions of rule 139, applicant is entitled to amend or present a showing of facts before the Primary Examiner.

2. SAME—SAME—SAME—SAME.

Where the applicant elects to prosecute the case before the Examiner, in an attempt to avoid the rejection brought out in the decision of the Board as to some of the claims held unpatentable, Held that *the decision of the Board can, and should be, regarded as not a final decision.*

3. SAME—SAME—SAME—SAME.

Where the additional references cited by the Board apply only to some of the claims and the applicant elects to prosecute the case further before the Examiner, Held that when the prosecution is concluded before the Examiner the case should be called by the latter to the attention of the Board, unless applicant appeals from a further final rejection.

4. SAME—SAME—TIME FOR FILING RESPONSE BEFORE EX-
AMINER.

Since a statement by the Board of additional grounds for refusing a patent stands, under the provisions of

rule 139, as a rejection, applicant has the statutory period of six months within which to respond.

ON PETITION.

Application for patent for kitchen furniture.

Mr. Donald H. Sweet for the applicant.

KINNAN, Acting Commissioner:

Applicant petitions that this case be remanded to the Primary Examiner for further consideration, in view of the statement contained in the decision of the Board of Appeals that certain claims are unpatentable over newly-discovered references cited by that tribunal.

The decision was rendered on June 30, 1927, affirming the action of the Examiner as to all the appealed claims. In this decision *the Board of Appeals cited two additional references against one only of such appealed claims*, one reference being specifically applied to this claim. In response to applicant's petition that the case be remanded, in view of such citation, to the Primary Examiner, the Board of Appeals in a decision rendered June 28, 1927, a copy of which apparently was not mailed to the applicant until September 2, 1927, stated that the citation of one of these references was such as to entitle the applicant to amend, but the citation of the other was not, since it was only used as an illustration of the argument made in response to that of applicant. The Board set 30 days within which amendment might be presented with reference to claim 4, that being the particular claim in question.

An applicant is entitled to be heard in connection with any new reference or reason presented in denying his claim of invention. To this end rule 139, as revised July 28, 1927, provides that the Board of Appeals, if it discovers any ground other than that involved in the appeal for refusing a patent, shall so state in its decision and that this statement will reopen the case for amendment or showing of facts before the Primary Examiner responsive thereto and shall be binding upon the Examiner, unless the showing is sufficient to over-

come the additional ground for rejection. The rule further provides that the applicant may waive his right to have the case reconsidered by the Primary Examiner and either ask for reconsideration by the Board of Appeals or treat the decision, including the added ground for rejection, as a final decision in the case.

In view of the fact that an appeal lies directly from the decision of the Board of Appeals to the Court of Appeals of the District of Columbia and that, under the rules of that court, such an appeal must be taken within 40 days after the decision, it would seem that, where the applicant elects to go back to the Primary Examiner, *the decision of the Board can and should be regarded as not a final decision in the case.*

If, after the Examiner has considered the new grounds of rejection and any amendment seeking to avoid them, the case again is before the Board on further appeal, *a final decision on all the appealed claims can be rendered.* So far as those claims are concerned, with regard to which the decision of the Examiner denying them was previously affirmed without citation of new references or reasons, the Board may merely state that it adheres to its original ruling.

As to the other claims if the applicant has convinced the Examiner of their allowability over all grounds of rejection including those added by the Board it would then seem only necessary to call the Board's attention to this fact.

Should the Examiner still hold the claims denied by the Board on new grounds unpatentable after argument or amendment, he should, whenever the case is again appealed and such claims are included in the appeal, furnish an additional statement of his reasons for denial of those claims. This practice appears necessary, since *otherwise the applicant would be forced either to abandon his right to go back to the Examiner or to take the case to the court without an issue having been reached as to part of the appealed claims.*

It is evident, under the rule, that the statement made by the Board of Appeals is to be regarded as a rejection because the rule provides that the applicant

may respond thereto either by amendment or a showing of facts. This should include the right to respond as to any and every reference deemed by the Board as of sufficient importance to be added in support of its new grounds of rejection.

It is, under the settled procedure, not necessary for the Examiner to take any action following the Board's decision in which the statement of further grounds of rejection is included until response has been made by the applicant. This being so, it would seem that the applicant, if he elects to have the case remanded to the Primary Examiner, would have a right to respond thereto at any time within the statutory six months from the date of the decision of the Board of Appeals.

It is noted in this case that the Board's decision was rendered June 30, 1927, and therefore the time for response before the Primary Examiner will expire December 30, 1927.

The petition is granted to the extent indicated. (Italics supplied.)

